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| | | | T CONTRACTOR | CONFIRMATION NO. |
|-----------------------|-------------------|----------------------|------------------------|------------------|
| | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIGNATION NO. |
| APPLICATION NO. | FILINODATE | 21.11 .35 | FIS920010261US1 | 4441 |
| 10/026,239 | 12/21/2001 | James N, Humenik | | |
| 10/020,229 | | | EXAMINER | |
| 32074 7590 12/03/2003 | | | MARKOFF, ALEXANDER | |
| INTERNAT | TIONAL BUSINESS I | MACHINES CORPORATION | Militeo | |
| DEPT. 18G | | | ART UNIT | PAPER NUMBER |
| BLDG. 300- | 482 | | | |
| | | | 1746 | |
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| HOPEWELI | JUNCTION, NY 125 | 33 | DATE MAILED: 12/03/200 | 13 |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|---|---|---|---|-----------------------|--|--|--|
| Office Action Summary | | ication No. | Applicant(s) | | | | |
| | | 26,239 | HUMENIK ET AL. | | | | |
| | | niner | Art Unit | | | | |
| | | ander Markoff | 1746 | | | | |
| The MAILING DATE of this cor | nmunication appears o | n the cover sheet w | ith the correspondence ac | idress | | | |
| Period for Reply | | | | | | | |
| A SHORTENED STATUTORY PERI THE MAILING DATE OF THIS COM Extensions of time may be available under the pre after SIX (6) MONTHS from the mailing date of the If the period for reply specified above is less than If NO period for reply is specified above, the maxi Failure to reply within the set or extended period to Any reply received by the Office later than three in earned patent term adjustment. See 37 CFR 1.70 Status | MUNICATION. poisions of 37 CFR 1.136(a). In is communication. thirty (30) days, a reply within th mum statutory period will apply a for reply will, by statute, cause the nonths after the mailing date of the mailing date of the mailing date. | no event, however, may a ne statutory minimum of thi and will expire SIX (6) MO ne application to become A | reply be timely filed rty (30) days will be considered time NTHS from the mailing date of this of BANDONED (35 U.S.C. § 133). | ly. communication. | | | |
| 1) Responsive to communication | s) filed on <u>21 Decemb</u> | <u>oer 2001</u> . | | | | | |
| 2a) This action is FINAL. | 2b)⊠ This action | is non-final. | • | | | | |
| 3) Since this application is in conclosed in accordance with the | | | | e merits is | | | |
| Disposition of Claims | | | | | | | |
| 4)⊠ Claim(s) <u>1-16</u> is/are pending in | the application. | | | | | | |
| 4a) Of the above claim(s) | | n consideration. | | | | | |
| 5) Claim(s) is/are allowed. | | | • | | | | |
| 6)⊠ Claim(s) <u>1-16</u> is/are rejected. | | | • | | | | |
| 7) Claim(s) is/are objected | to. | | | | | | |
| 8) Claim(s) are subject to | estriction and/or electi | ion requirement. | • | | | | |
| Application Papers | • | | | | | | |
| 9) ☐ The specification is objected to | by the Examiner. | | | | | | |
| 10)⊠ The drawing(s) filed on <u>21 Dec</u> | <u>ember 2001</u> is/are: a)[| accepted or b) | objected to by the Exar | niner. | | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | | | | | |
| Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). | | | | | | | |
| 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152. | | | | | | | |
| Priority under 35 U.S.C. §§ 119 and 12 | 0 | • | | | | | |
| 12) Acknowledgment is made of a a) All b) Some * c) Non | e of: | | § 119(a)-(d) or (f). | | | | |
| Certified copies of the piece. Certified copies of the piece. | | | Application No | | | | |
| 3. Copies of the certified co | opies of the priority dod | cuments have beer | • • | Stage | | | |
| application from the Inte | | | | | | | |
| * See the attached detailed Office 13) Acknowledgment is made of a c | | | | al application) | | | |
| since a specific reference was in | | | | | | | |
| 37 CFR 1.78. | 37 CFR 1.78. | | | | | | |
| a) The translation of the foreign language provisional application has been received. | | | | | | | |
| 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78. | | | | | | | |
| Attachment(s) | • | ı | | | | | |
| 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Re 3) Information Disclosure Statement(s) (PTO-1 | | | Summary (PTO-413) Paper No Informal Patent Application (PT | | | | |
| O, P. S. Information Disclosure Statement(s) (F 10-1 | | J L Julei. | • | • | | | |

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The serial number of the related application is missing on page 1, line 4.

Appropriate correction is required.

Drawings

2. The drawings are objected to because they fail to comply with the requirements of 37 CFR 1.84 (e). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,280,527 in view of Spring (Metal Cleaning).

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The claims US Patent No 6,280,527 disclose cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures.

The Patent does not teach electrolytic cleaning or two-step process wherein the electrolytic cleaning follows the non-electrolytic cleaning.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes.

See page 68.

It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patent to enhance the cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes.

Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- 7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 - 1. Determining the scope and contents of the prior art.
 - 2. Ascertaining the differences between the prior art and the claims at issue.
 - 3. Resolving the level of ordinary skill in the pertinent art.
 - 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over any one U.S. Patent No. 6,280,527 and 6,277,799 in view of Spring (Metal Cleaning).

The applied references have a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and

reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

US Patents No 6,280,527 and 6,277,799 teach cleaning paste residues with a claimed solution by claimed techniques and at claimed temperatures.

The Patents do not teach electrolytic cleaning or two-step process wherein the electrolytic cleaning follows the non-electrolytic cleaning.

However, Spring teaches that it was conventional in the art to electrolytic clean articles after non-electrolytic cleaning with the same electrolyte. See pages 67-73, especially page 68.

Moreover, Spring teaches that electrolytic cleaning reduces release of fumes. See page 68.

It would have been obvious to an ordinary artisan at the time the invention was made to include electrolytic cleaning in the method of the Patents to enhance the cleaning and to reduce the fuming and thereby reduce the health hazard for operators with reasonable expectation of adequate results because Spring teaches that electrolytic cleaning was conventionally used for these purposes.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on 703-308-4333.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703--308-0651.

Alexander Markoff Primary Examiner Art Unit 1746

am

ALEXANDER MARKOFF
PRIMARY EXAMINER